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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,218	08/19/1999	JEFFRY JOVAN PHILYAW	PHLY-24.706	8858
25883	7590	03/23/2004	EXAMINER	
HOWISON & ARNOTT, L.L.P P.O. BOX 741715 DALLAS, TX 75374-1715			THOMPSON, MARC D	
			ART UNIT	PAPER NUMBER
			2144	
			DATE MAILED: 03/23/2004 25	

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application No.

09/378,218

Applicant(s)

PHILYAW ET AL.

Examiner

Marc D. Thompson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) 3 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application. Applicant's submission filed on 12/31/2003 has been entered as Amendment D, Paper #24, into record.
2. Claims 1-14, and 16-19 remain pending.

Priority

3. This application is a continuation-in-part (CIP) of application number 09/151,530, filed 9/11/1998, now U.S. Patent Number 6,098,106. Presently claimed subject matter directly supported in this patented document is entitled to this effective priority filing date. All new subject matter set forth in the claims (and specification) is not so entitled.
4. The claimed invention set forth in this application (entire combination of independent limitations) will be treated with an effective filing date of 8/19/1999.

Drawings

5. The Examiner contends that the drawings submitted on 1/29/2001 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

8. Claims 1-2, 4-7, 9-14, and 16-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Portuesi (U.S. Patent Number 5,774,666), hereinafter referred to as Portuesi, in view of Sherman (U.S. Patent Number 5,213,337), hereinafter referred to as Sherman, in view of Hudetz et al. (U.S. Patent Number 5,978,773), further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

9. Portuesi disclosed the embedding of URL information in a multimedia presentation, i.e., video with audio. See, inter alia, Column 2, Lines 22-38. The multimedia information was fully capable of being recorded and played back later, e.g., from a computer file, CD, or DVD. See, inter alia, Column 3, Lines 22-29. Further, referenced data was presented during rendering of the digitally stored multimedia information. See Column 2, Lines 39-59. Additional, URL association was enabled to occur specifically with audio information. See Column 3, Lines 30-35, and Column 5, Lines 5-10. The current asserted novelty drawn to a “user perceivable code” was also fully disclosed by Portuesi in Column 6, Lines 12-14; if the displayed hyperlink displays the actual URL address, the code was user perceivable. Thus, Portuesi disclosed the invention substantially as claimed.

10. Portuesi did not disclose two important aspects of the presently claimed and disclosed invention. First, Portuesi did not specifically disclose the use of embedded audio signals which were recognizable to either the rendering machine or a human viewer to effect information

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retrieval. Second, Portuesi did not specifically disclose effecting information retrieval through the use of a predetermined identification number which corresponded to particular vendor products or services.

In regard to embedded audio signals, Portuesi did expressly disclose the encoding of URL information into the digital multimedia. See, inter alia, Column 9, Lines 5-8, and Figure 5, reference numeral 62. This resulted in a digital video signal (including audio) with embedded URL information, expressly disclosed as capable for digital storage on, inter alia, video disk(s). See, inter alia, Column 9, Lines 3-21. While Portuesi provided a single example for express encoding of the URL information into the multimedia file (Column 9, Lines 8-11), the language used was intentionally open-ended, suggesting other methods of information encoding as potentially used with the concept of invention. This would have motivated one of ordinary skill in the art at the time the invention was made to explore related teachings to find suitable means for embedding/encoding URL information into multimedia information.

In regard to information retrieval based on identification numbers which correspond to particular products or services, the natural extension of information relating to product(s) or service(s) being delivered to a requesting or unsolicited consumer in parallel with video and/or audio advertisements would have been obvious to one of ordinary skill in the art at the time of invention. This would have motivated one of ordinary skill in the art to explore product information retrieval techniques for this purpose; the linking of timely, relevant information corresponding to specific products or services during advertisements would have been recognized as desirable by one of ordinary skill in the art at the time of invention.

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11. In the related art of television (video) and radio (audio) and the encoded use of audio controlling signals, Sherman disclosed the embedding of "substantially indiscernible" audio touch tones which effect functionality of a reception device and the use of these embedded tone(s) on recorded media. See, inter alia, Column 2, Lines 28-47, and Column 3, Lines 14-17. The audio enabled value embedding as disclosed by Sherman provided yet another type of information encoding for use in the Portuesi system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use encoding/embedding as described by Sherman in the encoding/embedding system described by Portuesi in order to encode strings of values in an audio/video presentation corresponding to URL network address(es) to correlate information with the currently rendered video/audio presentation. Since the audio tones were "substantially indiscernible", it is clear that the tones were "perceivable", and "user perceivable" as claimed.

12. In the related art of database information look-up, Hudetz disclosed the correlation of identification numbers with particular products and vendor information/offers concerning these product(s) using a network of remote database(s). See, inter alia, Column 3, Lines 17-24. It is also noted that Hudetz specifically disclosed two important details: (1) the encoded identification number(s) were in "human and/or machine readable form" (Column 3, Lines 27-28), and (2) an identification number was input which resulted in retrieval of an actual or logical network address (routing information, as claimed) through use of a [usually, remotely] located database for number to address look-up (Column 3, Lines 25-37). In regard to the latter, in light of these cited portions of the Hudetz teachings, the provision for UPC barcode operation for input of identification number(s) did not preclude the use of other types of input device(s), methods,

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human or machine actuated input, or specific type(s) of alphanumeric string(s) which resulted in arbitrary identification number(s) to physical or logical network address mapping. See Column 3, Lines 25-37. That is, the use of UPC numeric codes scanned by a peripheral reading device was only one way to achieve the invention as described; a numerical value corresponding to the designated information for database lookup was the crux of the invention as disclosed.

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Portuesi and Sherman providing embedded information within multimedia presentations with the numerical to network address correlation provided by Hudetz, for example, in order to minimize the amount of information added to any given stored or compiled multimedia presentation. Bandwidth conservation and digital storage space was widely recognized as an inherent concern in the computer arts, and minimizing the amount of encoded information in a given multimedia presentation would have been readily evident. The provision for a short string, (e.g., eight or ten numbers) which effects the same information transfer functionality as a much longer URL or product identification designation and network address would have been obvious to one of ordinary skill in the art at the time the invention was made. See, inter alia, Hudetz, Column 3, Lines 1-13, and Column 11, Lines 21-27.

14. In short, Portuesi disclosed a digital multimedia transmission incorporating codes used to effect information retrieval over a network at a user location, Sherman provided a method for audio signal embedding also effecting information transfer on a network, and Hudetz used centralized location of URL information for current, proper information delivery. The combination of these teachings, and any/all modification of the Portuesi base system with the

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remaining teachings would have been obvious to one ordinary skill in the art at the time of invention since all the teachings reside in the same art of network information transfer, and each modular, functional concept elaborated on similar concept(s) provided in the other references. The resulting system would have simply been a straight forward extension of these teachings.

15. This combination of teachings expressly disclosed each and every limitation of the claimed invention as set forth:

(claim 1, 6, 11, 12, 13, 16)

1. *Recorded [digital] information on [digital media]*, was taught, inter alia, by Portuesi in Column 3, Lines 23-26, and was taught by Sherman in Column 3, Lines 14-16. Further, the media which storage takes place on was completely arbitrary and a wide variety of digital storage mediums would have been obvious to one of ordinary skill in the art at the time of invention.

2. *Embedding a unique user perceivable code in digital video information*, was taught, inter alia, by the combination of teachings found in Portuesi, Column 6, Lines 33-46, and Sherman, Column 3, Lines 7-36. Also see, Portuesi, Column 6, Lines 12-14, for an express teaching of a user perceivable code; if the hyperlink specified the actual URL, clearly this is user perceivable.

3. *Unique user perceivable code is output during normal playback of the [video]*, was taught, inter alia, by Portuesi in Column 5, Lines 64-66, and Sherman, Column 3, Lines 14-17.

4. *Unique user perceivable code [mapping to] vendor routing information defining the route over the network from a user location to a vendor location*, was taught, inter alia, by

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the combination of teachings provided by Portuesi by related URL inclusion, and Hudetz, Column 3, Lines 15-37. It is clear Hudetz expressly disclosed the user centralized storage of routing information to effect information retrieval.

5. *Operating the disk [by rendering in information thereon] (reading the data and outputting the data on a display)*, was taught, inter alia, by Portuesi in Column 3, Lines 22-29, and Sherman, Column 3, Lines 14-17.

6. *Extracting the unique user perceivable code during output at the user location*, was taught, inter alia, by Portuesi in Column 5, Lines 64-66, and Sherman, Column 3, Lines 14-17.

7. *Transmitting the unique user perceivable code to an intermediate location on the network*, was taught, inter alia, by Hudetz in Column 3, Lines 15-24.

8. *Returning routing information to the user location used to access information from a vendor*, was taught, inter alia, by Hudetz in Figure 5.

(claim 2, 7, 17, 18, 19)

9. *Accessing a database of vendor routing information, database [correlating] the unique user perceivable code to routing information for a vendor*, was taught, inter alia, by Hudetz in Figure 4.

10. *[Using the unique user perceivable code for] interconnecting the user [computer] with vendor information*, was taught, inter alia, by Hudetz in Figure 5.

(claim 4, 9)

11. *Routing information is a URL, Routing information is a URL*, was taught, inter alia, by Hudetz in Column 3, Lines 25-37.

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(claim 5, 10)

12. *Unique perceivable code is an audible tone*, was taught, inter alia, by Sherman in Column 3, Lines 7-36

(claim 14)

13. *Playback is integrated with the user computer*, was taught, inter alia, by Portuesi in Column 2, Lines 50-52.

16. Since all the claimed limitations set forth in claims 1-2, 4-7, and 9-19, were expressly disclosed by the combination of teachings provided by Portuesi, Sherman, and Hudetz, claims 1-2, 4-7, 9-14, and 16-19, are rejected.

17. Claims 1-2, 4-7, 9-14, and 16-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Solvason (U.S. Patent Number 6,003,073), hereinafter referred to as Solvason, in view of Hudetz (U.S. Patent Number 5978,773), hereinafter referred to as Hudetz. Further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

18. Applicant admits in the response, Paper #24, received on 12/31/2003, at Page 10, Line 22 through Page 11, Line 4, that the teachings of Solvason disclosed “embedding audio signals that are perceivable and which are utilized to effect a connection with a remote location, but the codes are not transmitted to an intermediate location”. Thus, Solvason disclosed the invention substantially as claimed, but failed to expressly disclose centralized storage and remote lookup of information relating to audio embedded codes.

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19. Solvason specifically recited "...control information...may be used by any member of the listening or viewing public having access to a personal computer equipped with means to retrieve and use the control information..." and "...communication between the user installation and the 'Internet' or similar types of computer networks..." See, inter alia, Column 2, Lines 33-39, and Column 9, Line 60 through Column 10, Line 4. However, Solvason remained silent to specifics as to how these networks were specifically utilized to effect information retrieval, motivating an ordinary artisan to explore the Internet arts for similar teachings to enable the use of the Internet for information exchange.

20. In these arts, Hudetz disclosed the correlation of identification numbers with particular products and vendor information/offers concerning these product(s) using a network of remote database(s). See, inter alia, Column 3, Lines 17-24. It is also noted that Hudetz specifically disclosed two important details: (1) the encoded identification number(s) were in "human and/or machine readable form" (Column 3, Lines 27-28), and (2) an identification number was input which resulted in retrieval of an actual or logical network address (routing information, as claimed) through use of a [usually, remotely] located database for number to address look-up (Column 3, Lines 25-37). In regard to the latter, in light of these cited portions of the Hudetz teachings, the provision for UPC barcode operation for input of identification number(s) did not preclude the use of other types of input device(s), methods, human or machine actuated input, or specific type(s) of alphanumeric string(s) which resulted in arbitrary identification number(s) to physical or logical network address mapping. See Column 3, Lines 25-37. That is, the use of UPC numeric codes scanned by a peripheral reading device was only one way to achieve the

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invention as described; a numerical value corresponding to the designated information for database lookup was the crux of the invention as disclosed.

21. These teachings paralleled the teachings of Solvason such that the modification of the information retrieval system set forth by Solvason with the centralized database of Hudetz would have been obvious to one of ordinary skill in the art at the time of invention in order to provide current information retrieval, for example, in the event of network information address change. See, inter alia, Hudetz, Column 3, Lines 1-13.

22. Thus, is it unclear of any difference between the combination of these two well known functional system types in light of the claimed invention.

23. Claims 1-2, 4-7, 9-14, and 16-19 are rejected.

Allowable subject matter

24. Claims 3 and 8 are once again objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

25. The arguments presented by Applicant in the response, Paper #24, received on 12/31/2003, are not considered persuasive.

26. Applicant argues distinguishing the presently claimed invention through use of the word "perceivable". This word is now argued by Applicant to relate to "user perceivable" code(s) embedded in the "audio/video bandwidth". See, Response, Amendment D, Paper #24, received 12/31/2003, inter alia, Page 8. Since "user perceivable codes" were within the scope of the art

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and previous discussions regarding these multimedia embedded codes used to effect information retrieval over a network, this line of argument is not considered persuasive.

27. Applicant asserts a difference between “broadcasted” audio and video and embedding audio/video on a digital media. This line of argument is not persuasive, since, the recording of audio and video has existed for many decades. Any provision for digital storage of audio/video and other digitally associated information has also existed for many years prior to the filing of the present claims. As previously evidenced by Examiner multiple times, the provision for digital storage of information, such as audio and/or video, was notoriously well known and widely implemented in the art prior to Applicant’s filing. Further, digital multimedia files which contain user conceivable codes for information retrieval, were also known. This line of argument is not persuasive.

28. Examiner takes Official Notice (see MPEP § 2144.03) that the storage of audio, video, and embedded coded information in a digital file (or set of digitally stored files) in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states “See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice).” Specifically, *In re Boon*, 169 USPQ 231, 234 states “as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that

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was needed". Further note that 37 CFR § 1.671©(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

29. As a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Sherpard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 545 (CCPA 1977). Lastly, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), clearly states "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper".

30. Applicant arguments are not substantive enough to warrant detailed discussion. The breadth of the claims and the breadth of the discussion by Applicant is hindering advancement of the claimed subject matter. Significant detail (for example, incorporation of claims 2 and 3 into

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independent claim(s) 1, 6, and 11) is suggested as a starting point, to overcome the issue(s) of breadth, similarity of the claimed invention and the prior art, and isolation of the feature(s) which Applicant considers to be the actual invention, not simply the prior art systems as were well known and widely implemented at the time of invention.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jack Harvey, can be reached at (703) 305-9705. The fax phone number for this Group is (703) 872-9306. Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

MARC D. THOMPSON
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PRIMARY EXAMINER

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Art Unit 2144